REMARKS

The title has been amended as requested by the Examiner. The amended title is based on language found in claim 1 and is thus clearly indicative of the "elected invention to which the claims are directed".

Several paragraphs of the specification were amended to replace references to specific claims by reproducing the text of those claims as filed. No new matter is added.

The non-elected claims have been cancelled above without prejudice or disclaimer. In addition certain other claims have been cancelled without prejudice or disclaimer as discussed below. Claims 1-9, 11-14, 58-63, 65-75, 77, 110, 113 and114 remain pending in this patent application. In addition, claims 117 and 118 have been newly added and are now also pending. Support for these new claims can be found in the specification at least at page 9, lines 1-9.

All of the claims were rejected under 35 USC 102(e) as being anticipated by Gourraud (US 2004/0037406 A1). The rejection is respectfully disagreed with and is traversed below.

Figure 1 of Gourraud shows a conventional 3GPP network for IP Multimedia session handling. There is a SIP application server 106 that contains application servers (APs) in the network. The user equipment (UEs) connect to the system via access network 130.

The Abstract of Gourraud, cited by the Examiner when rejecting claim 1, states:

A method and system for exchanging instant messages among participants to a conference call, wherein when an instant message is to be sent among the participants, the instant message is addressed by a first participant to the conference call itself, which is identified by a conference call URI. **An Application Server (AS) receives the message, and based on a memory-stored correspondence between the conference call URI and the conference call participants, translates the session URI into Public Ids, SIP URIs or any other identifier of each participant, or participant's terminal. The AS further relays the instant message to the other participants by addressing it to each participant's identifier.** The memory of the AS is updated as new participants join or leave the conference call, as to always reflect the participants currently involved in the conference call.

Paragraph [0027] of Gourraud, cited by the Examiner when rejecting claim 1, states:

With reference being further made to FIG. 2, at the beginning in action 212 UE A 202 and UE B 204 are engaged in conference call such as for example in a SIP-based conference call, also called herein a conference call, that is identified by a conference call Uniform Resource Identifier (URI) and controlled by the AS 208, which thus stores the conference URI and the identity of each participant to the conference call. It is also assumed that filter criteria associated with the conference call URI route all messages to the AS 208. **The conference call identifier may be stored in a memory M 214 of the AS 208, where it is associated with identities, preferably under the form of Public Ids, of the current participants to the conference call,** which in the present case and moment are UE A 202 and UE B 204. In action 214, UE A 202 desiring to send an instant message to the other participant(s) to the conference call, sends a SIP Message 214 to the S-CSCF 210, **the SIP Message comprising a destination under the form of the conference URI 216.** Upon receipt of Message 214, the S-CSCF 210 relays the former to AS 208. **The AS 208 extracts the conference URI 216 from the message, and using its memory-stored correspondence between the conference URI and the Public Ids of the current participants to the conference call, translates the conference URI into the identity of the other participants to the conference call,** which in the present case is only UE B 204, action 218. In action 220, **the AS 208 sends the Message issued by UE A**

**202 to the UE B 204, using the identity of the UE B that may for
example be the Public ID 222 for of the UE.** In action 224, the UE
B 204 receives the Message 220, which is displayed, played or run,
depending upon its nature, action 224.

Claim 1 has been amended to even further clarify the claimed subject matter, and
to incorporate subject matter based on that found in claim 10 as filed. Support for
the amendment to claim 1, and the other independent claims as well, can be found
in Figures 1-4 and the related portions of the specification.

When rejecting claim 10 the Examiner states that Instant Messaging (IM) requires
a subscriber to logon to the IM server using a conventional IM connection per
Figure 2 (URI) obtained from a memory (database) of the UE.

First of all, the URI in Figure 2 is the "conference call URI" that identifies a
particular conference call that is in progress. There is no suggestion that such a
conference call URI would be stored in a "buddy list" or an "address book"
database of the UE. The URI in Figure 2 simply identifies the conference call that is
currently active.

Further, claim 10 as filed recited in part that the <u>mobile telephone terminal</u> includes
a "memory for storing a database in which the instant messaging address of the
first party and a telephone number of the first party are associated together".

Clearly, the SIP application server of Gourraud is not disclosed as including this
subject matter. Instead, in the AS the "<u>conference call identifier</u> may be stored in a
memory M 214 of the AS 208, where it <u>is associated with identities, preferably
under the form of Public Ids, of the current participants to the conference call</u>".

Claim 1 as amended recites that an apparatus comprises:

> a user interface;
>
> a processor; and
>
> a memory that stores computer program code, where the memory and computer program code are configured, with the processor, to cause the apparatus at least to provide via said user interface a user with a selectable option during a telephone call with a first party, the selection of which initiates communication with the first party by instant messaging;
>
> where said **memory further stores a database comprising entries, and in which an instant messaging address of the first party and a telephone number of the first party are associated together in an entry associated with the first party.**

As is made clear in MPEP § 2131:

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). .."The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The teachings of Gourraud do not anticipate the subject matter claimed in claim 1, nor do they suggest or render obvious the subject matter of claim 1. In Gourraud the AS network component stores a conference URI (a URI that identifies the particular conference call that is in progress) and that is "associated with identities, preferably under the form of Public Ids, of the current participants to the conference call". Each and every element of claim 1 is clearly not found in Gourraud, and "the identical invention" as claimed is clearly not found in Gourraud. As such, claim 1 should be found to be allowable over Gourraud.

Claim 13 as amended is drawn to a method that comprises:

changing a mechanism by which a first party and a second party communicate during a communication session by

communicating via a telephone call between the first and second parties; and

displaying a user selectable option **on a display of a communication device** during the telephone call to at least one of the parties, the selection of which initiates the establishment of instant messaging between the parties, where

the communication device comprises a memory that stores a database comprising entries, and in which an instant messaging address of a party and a telephone number of the party are associated together in an entry associated with the party.

Claim 13 should also be found to be allowable over Gourraud.

Claim 14 as amended is drawn to a system that comprises:

a user interface and a data processor that operates in accordance with a program stored in a memory, where said processor is configured with the program **in response to user input via said user interface** to switch a communication session between the parties from a telephone call to instant messaging, **where the memory also stores a database comprising entries, and in which an instant messaging address of a party and a telephone number of the party are associated together in an entry associated with the party.**

Claim 14 should also be found to be allowable over Gourraud.

Claim 58 as amended is drawn to an apparatus that comprises:

a user interface;
a processor; and
a memory that stores computer program code, at least one mobile telephone application, an instant messaging client and a **database comprising entries in which an instant messaging address of a party and a telephone number of the party are associated together in an entry associated with the party,**
where the memory and computer program code are configured, with the processor, to cause the apparatus at least to display via said user

interface with the mobile telephone application an entry associated with a first party and to provide to a user, **while displaying the entry, a selectable option that is configured by said user interface to initiate instant messaging with the first party using the instant messaging address stored in the entry.**

Claim 58 should also be found to be allowable over Gourraud.

Claim 77 as amended is drawn to a method that comprises:

displaying on a display of a mobile telephone an entry associated with a first party, where displaying comprises accessing a database associated with a mobile telephone application, where the **database comprises a part of the mobile telephone and stores entries, each entry configured to store an instant messaging address of a party in association with a telephone number of the party**; and displaying on the display a user selectable option for enabling via user input an instant messaging client of the mobile telephone to **initiate instant messaging with the first party using the instant messaging address of the first party that is retrieved from the database that comprises part of the mobile telephone.**

Claim 77 should also be found to be allowable over Gourraud.

Claim 110 is drawn to an apparatus that comprises:

a processor; and
a memory that stores computer program code, at least one application from which a telephone call and instant messaging can be initiated, and a **database comprising entries in which an instant messaging address of a party and a telephone number of the party are associated together in an entry associated with the party,**
where the memory and computer program code are configured, with the processor, to cause the apparatus at least to, when the **application accesses a stored telephone number of a party in the database the stored instant messaging address of that party is automatically accessed or accessible and when the application accesses a stored instant messaging address of a party in the database, the stored telephone number of that party is automatically accessed or accessible.**

Claim 110 should also be found to be allowable over Gourraud.

In that the AS server of Gourraud does not anticipate or suggest the subject matter of the independent claims then for at least this reason all claims that depend from these independent claims should also be found to be allowable. Further in this regard, and by example only, it is not seen where the subject matter of claim 74 is disclosed or suggested, or the subject matter of claim 75 is disclosed or suggested.

The newly added claims 117 and 118 should also be found to be allowable over Gourraud, as Gourraud does not teach or suggest the claimed subject matter.

More specifically, aspects of claim 117 are as follows:

> **during an instant messaging session** with a second party that is conducted using an instant messaging client of a mobile telephone of a first party, **initiating at the mobile telephone of the first party a request to make a telephone call to the second party;**
> **sending a message** from the mobile telephone **to a server**, the message **comprising information identifying the second party;**
> **receiving information from the server**, the received information **comprising a telephone number of the second party;**
> processing the received information to **extract the telephone number** of the second party; and
> **making a telephone call from the mobile telephone of the first party to the second party using the extracted telephone number.**
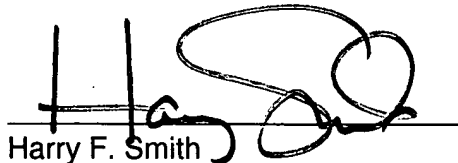
The disclosure of Gourraud was characterized above. For example, Gourraud discloses certain operations that are conducted during a telephone conference call, where an instant message is addressed by a first participant to the conference call itself, which is identified by a conference call URI. In response the Application Server, based on the memory-stored correspondence between the conference call URI and the conference call participants, translates the session URI into Public Ids, SIP URIs or any other identifier of each participant and relays the instant message to the other participants by addressing it to each participant's identifier.

Claim 117 is directed to a method performed "during an instant messaging session with a second party" to enable a mobile telephone of the first party to receive a telephone number of the second party from a server, to extract the received telephone number from information received from the server and to then make the telephone call to the second party.

The disclosure of Gourraud does not expressly teach or even suggesting this type of operation. As such, claim 117 should also be found to be in condition for immediate allowance, as should claim 118 that depends from claim 117.

A favourable reconsideration that results in the allowance of all of the now pending claims is earnestly solicited.

Respectfully submitted:

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